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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/520,840 | 01/07/2005 | Barbara Wagner | HU/1-22712/A/PCT | 2761 |

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| EXAMINER |
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HOLT, ANDRIAE M

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| ART UNIT | PAPER NUMBER |
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4133

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| MAIL DATE | DELIVERY MODE |
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11/15/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/520,840 | Applicant(s) WAGNER ET AL. | |
| | Examiner Andriae M. Holt | Art Unit 4133 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-19, drawn to a method of protecting human and animal hair or skin from UV radiation, which involves contacting hair or skin with an effective amount of compounds of formulas 1, 2 or 3.

Group II, claim(s) 20, drawn to a compound of formula 6.

The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the common technical feature in all groups is the compounds of formula 1, 2 or 3, merocyanine derivatives. Sieber et al. teach the selective killing of leukemia cells by merocyanine 540. Sieber et al. teach in vitro incubation of leukemic bone marrow with the lipophilic fluorescent dye merocyanine 540 and simultaneous exposure to light reduced the concentration of L1210 leukemia cells by about 5 orders of magnitude but spared enough normal pluripotent hematopoietic stem cells to allow hematopoietic reconstitution of lethally irradiated syngeneic mice. This simple and rapid procedure may find an application in the purging of tumor cells from autologous bone marrow

grafts (Abstract). These elements cannot be a special technical feature under PCT Rule 13.2 because the elements are shown in the prior art.

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

- a) Formula 1 of claim 1;
- b) Formula 2 of claim 1;
- c) Formula 2a of claim 2;
- d) Formula 2b of claim 17;
- e) Formula 3 of claim 1;
- f) Formulas 3a and 3b of claim 10;
- g) Formula 4 of claim 12;
- h) Formula 5 of claim 14;
- i) Formula 6 of claim 20.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The claims are deemed to correspond to the species listed above in the following manner:

- a) Applicant is required to elect a single formula for claim 1, formula 1, formula 2, or formula 3.
- b) Applicant is required to elect a single constituent for each group R^1 , R^2 , R^3 , R^4 , R^5 , R^6 , R^7 , l, m, n for the formula elected from formula 1, 2 or 3.
- c) If formula 2 is elected, applicant is required to elect a single constituent for each group in formula 2a and 2b, R^1 , R^2 , R^3 , R^4 , R^5 , R^6 , R^7 , Z_1 , Z_2 , l, m, and n, in claim 2 and claim 18.
- d) If formula 3 is elected, applicant is required to elect a single constituent for each group in formula 2a, R^1 , R^2 , X, Z_2 and n, in claim 10.
- e) Applicant is required to elect a single constituent for each group in formula 4, R1, R2, R3, R5, and R6, in claim 12.
- f) Applicant is required to elect a single constituent for each group in formula 5, R^1 , R^2 , R^3 , and R^5 , in claim 14.
- g) Applicant is required to elect a single constituent for each group in formula 6, R^1 , R^2 , R^5 , and m, in claim 14.

The following claim(s) are generic: 1 and 20.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: the common technical feature in all groups is the compounds of formula 1, 2 or 3, merocyanine derivatives. Sieber et al. teach the selective killing of leukemia cells by merocyanine 540. Sieber et al. teach in vitro incubation of leukemic bone marrow with the lipophilic fluorescent dye merocyanine 540 and simultaneous exposure to light reduced the concentration of L1210 leukemia cells by about 5 orders of magnitude but spared enough normal pluripotent hematopoietic stem cells to allow hematopoietic reconstitution of lethally irradiated syngeneic mice. This simple and rapid procedure may find an application in the purging of tumor cells from autologous bone marrow grafts (Abstract). Though the compounds of formula 1-6 are merocyanine derivatives,

depending on the constituents chose, the compound would have a varying number of compounds and properties and a varying number of reactions when used to protect human and animal hair or skin from UV radiation. These elements cannot be a special technical feature under PCT Rule 13.2 because the elements are shown in the prior art.

The examiner has required restriction between product and process claims.

Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double

patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

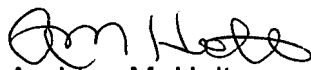
The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

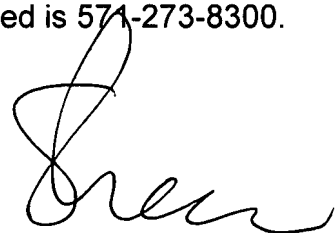
Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103 (a) of the other invention.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andriae M. Holt whose telephone number is 571-272-9328. The examiner can normally be reached on 9:00 am-5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Andriae M. Holt
Patent Examiner


SHELLEY A. DODSON
PRIMARY EXAMINER